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EXAMINER

GALL, LLOYD A

ART UNIT PAPER NUMBER

3676

DATE MAILED: 09/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/858,457

Applicant(s)

LAX ET AL.

Examiner

Lloyd A. Gall

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-62 and 66-81 is/are pending in the application.

4a) Of the above claim(s) 9-11, 14, 19, 24, 27-30, 34, 36, 37, 46, 47, 53, 54 and 66-68 is/are withdrawn from consideration.

- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 12, 13, 15-18, 20-23, 25, 31-33, 35, 38-41, 44, 45, 48, 51, 52, 55-62, 69-74 and 76-81 is/are rejected.
- 7) ☒ Claim(s) 26, 42, 43, 49, 50 and 75 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 October 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

DETAILED ACTION

Applicant's election with traverse of the elected invention Group I, and the storage case embodiment of figs. 1-22 in Paper No. 18 is acknowledged. The traversal is on the ground(s) that the search and examination of all claims and figures can be made without serious burden. This is not found persuasive because the numerous claims, (both original and amended) and embodiments set forth on page 3 of the last Office action clearly set forth an additional burden on the examiner.

The requirement is still deemed proper and is therefore made FINAL.

Claims 9-11, 14, 19, 24, 27-30, 34, 36, 37, 46, 47, 53, 54 and 66-68 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention/species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 18.

Applicant should further note that, in response to the listing of elected claims on page 20 filed on June 12, 2003, it is noted that in addition to the listing of claims by applicant which do not read on the elected embodiment, claims 9-11, 14, 19, 24, 27-30, 34, 36, 37, 46, 47, 53, 54 and 66-68 are not regarded by the examiner as reading on the elected embodiment of figs. 1-22. Specifically, the void of claim 9, line 7 is set forth as element 157 in the embodiment of fig. 24. The cut-away of claim 14, line 2 and claim 24, line 26 is defined as element 616 of fig. 52. The first and second hooks (pg. 21, line 11 of the specification) of claim 19 and hook edges of the last two lines of claim 66 are drawn to the fig. 24 embodiment. The high lubricity of claim 36 is drawn to the fig. 33 embodiment (pg. 23, line 8). Elected figs. 1-22 do not include the chamfered portion of

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claim 37. With respect to the remarks concerning claim 54, it is noted that claim 54 is drawn to a lock, and does not positively claim the storage case. The intended use of claim 54 with a storage case does not entitle claim 54 to be examined with elected claim 55. See page 2 of the restriction requirement of May 9, 2003.

The disclosure is objected to because of the following informalities: On page 1, line 3, the serial number and its status should be included. On page 9, line 18, 614 refers to an indent on page 8, line 15. On page 11, line 26, "14a, 14b, 14c and 14d" is inaccurate. On page 12, line 3, in what sense is element 432 a "notch"? On page 12, line 5, in what sense is element 434 "arcuate" in nature? On page 12, line 19, "piece" should apparent read -pierce--. On page 15, line 10, "220" should read -400--. On page 15, line 10, "234,236" should read -410, 412--. On page 15, line 12, "an" should read -and--. On page 16, line 1, "protrusions" should read -protrusion--. On page 17, lines 11 and 13, "62" appears to be inaccurate. On page 17, lines 15 and 20, "50" appears to be inaccurate. On page 19, line 5, the status of the serial number should be updated. On page 24, line 4, "15" should read -35--. On page 24, line 18, "18" and "15" are inaccurate. On page 26, line 6, "260" should read -262--. On page 27, lines 22 and 23, "304, 306" should be replaced with -294, 296--. On page 28, line 21, the second occurrence of "348" should read -352--. On page 28, line 26, "352" should read -348--. On page 29, lines 21, 25 and 26, "344" should read -358--. On page 29, line 21, "340" should read -354--. On page 30, lines 1 and 2, "346, 348" should read -360, 362--. On page 30, line 12, "150" should be deleted. On page 34, line 19, "400" should read -4400--.

Appropriate correction is required.

The drawings are objected to because reference numeral 208b (pg. 10, line 8) cannot be located, nor can numerals 401 (pg. 13, line 21), 454 (pg. 14, line 1), 706 (pg. 15, line 14), 208b (pg. 22, line 4), 316 (pg. 27, line 21), 406, 408 (pg. 33, line 11), 568 (pg. 34, line 11), 461 (pg. 34, line 13) and 4400 (pg. 34, line 19). In fig. 52, numeral 60 should be replaced with --606-- (pg. 32, line 6). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The written description should provide support for the "groove" of claim 33, line 4 and the "third position" of claim 49.

Claims 61 and 73 are objected to because of the following informalities: In claim 61, line 4, "recording" should read --storage--. In claim 73, line 1, "device" should be deleted. Appropriate correction is required.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 40 and 41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 40, line 3, it is not clear in what sense element 432 is a "notch". In claim 40, line 4, it is not clear in what sense element 434 is "arcuate".

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In view of this rejection, claims 40 and 41 are rejected as best understood, on prior art, as follows.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-8, 12, 20, 21, 25, 33, 35, 38-41, 44, 45, 48, 51, 52, 55, 56, 69-74 and 77-81 are rejected under 35 U.S.C. 102(a) as being anticipated by the PCT reference (877).

The PCT reference (877) teaches a storage case capable of receiving recording medium, including first and second covers 12, 14 hinged about a spine, as seen in fig. 16, the inner area of each cover defining a seating area as well as a base, first and second intermeshing lock portions or lock receiving members 78, 93 on the covers which also define collinear hollow voids, the lock portions defining a combined lock path having an indent or entrance at 80 of both covers also capable of receiving one's finger, and a closed back wall at the left side of the lock portions as seen in fig. 16. As seen in fig. 16, the portions labeled 93 and 78 are regarded as forming U-shaped loops. The combined lock paths receiving substantially all of a lock 84, 86 as seen in fig. 12 and 13, the lock including a back wall at its topmost portion of fig. 12, the lock including a base (84 and the plates which extend radially outward therefrom which hole resilient catches 86), these catches defining alternating projections 86 and indentations defined by the

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spring arms which hold the protrusions 86 which defines a noise maker when the lock is slid into the combined lock paths and the catches 86 spring back and forth. With respect to claim 25, the protrusions 86 are capable of moving between a first position extending beyond the periphery of the base (which base includes the radial legs extending outward from element 84), and a second position extending springing inward which does not extend from the periphery of the base. With respect to claim 33, an unlabeled groove extends midway along the length of the base 84, as seen from the bottom of fig. 12. The protrusions spring inwardly into a void of the base 84, and the bottom of the lock may be regarded as a torpedo-shaped nose. With respect to claim 48, the plural catches 86 extend in different directions with respect to one another.

Claims 55, 57-59, 69-72, 79 and 80 are rejected under 35 U.S.C. 102(b) as being anticipated by Burdett et al (185).

Burdett teaches a storage case including first 12 and second 14 covers defining a seating area on a shelf 16, a lock 110, 114 to be disposed within loop portions 62, 64 of the aligned interleaved cover locking elements 22, 60, 26 as seen in fig. 15. The lock 110 as seen in fig. 14 is disposed on both on top of and below the medium and shelf.

Claims 1-7, 20, 55 and 56 are rejected under 35 U.S.C. 102(b) as being anticipated by the EP reference (311).

The EP reference (311) teaches a storage case with first and second covers 1, 2 capable of receiving a storage medium in a seating area of the cover 1, and including lock portion loops 3, 7 aligned to receive substantially all of a lock 5. With respect to

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claims 6 and 7, a wall is formed on the case 2 in front of the torpedo-shaped nose 4 as seen in fig. 1.

Claims 1-4, 20, 25, 35, 38, 39, 44, 45, 48, 55, 56, 69, 80 and 81 are rejected under 35 U.S.C. 102(b) as being anticipated by Eichner (955).

Eichner teaches first and second cover bases 10, 18 having a seating area, and aligned loops 24, 36 as seen in fig. 2 to receive a lock 30, 32, 34 therein. The lock includes a base 34 and catches 36 as seen in fig. 3 movable beyond the periphery of the base and within the periphery of the base as they move radially inward into a void. The base of the catches are defined by a leaf spring. The lock includes a wall 30 at a first end and a torpedo-shaped nose 34 at a second end.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 15-18, 57-59, 61 and 62 are rejected under 35 U.S.C. 103(a) as being unpatentable over the PCT reference (877) in view of Belden (788).

Belden teaches a document retaining member 26 regarded as a gripping element rib, and a central hub 62 and shelf 108, 110 on the opposite cover. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a hub, shelf and ribs on the covers of the PCT reference (877), in view of the teaching of Belden, the motivation being to securely hold a recording medium and documents. With respect to claims 58 and 59, in modifying the PCT reference, its lock would extend on

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top (or to the right of as seen in fig. 13) of the medium and shelf, and the lock would have its protrusions 86 both above and below the medium and shelf.

Claims 31, 32 and 76 are rejected under 35 U.S.C. 103(a) as being unpatentable over the PCT reference (877) in view of Murphy (445).

Murphy teaches that it is well known to include a notch at 15, 16 of a spring-arm catch. To provide a notched recess in the catches 86 of the PCT reference, would have been obvious in view of the teaching of Murphy, the motivation being to provide a strong locking contact between the catches 86 and the covers. With respect to claim 32, the PCT reference teaches a second smaller height at the lower free end of the lock as seen in fig. 12, with respect to the greater height at the top of the lock.

Claim 60 is rejected under 35 U.S.C. 103(a) as being unpatentable over the PCT reference (877) in view of Lax (922) and Ditzig et al (299).

Lax teaches an ejecting spring 52 positioned on a lock, and Ditzig teaches that an ejecting spring 90 is well known to be in a hook form. To provide a spring arm ejecting spring for the lock of the PCT reference (877) would have been obvious in view of the respective teachings of Lax and Ditzig et al, the motivation being to aid in releasing the lock from the covers, to simplify disassembly.

Claims 12, 13 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over the EP reference (311) in view of Schurman (381) or the PCT reference (877).

Schurman teaches plural intermeshed lock portions 34, 38 to receive a lock 26, as does the PCT reference teach plural intermeshed lock receiving elements, as discussed above. To modify the loops of the EP reference (311) to include plural intermeshed

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loops on each cover, would have been obvious in view of the teaching of either Schurman or the PCT reference (877), the motivation being to optimize the strength of the lock between the two covers.

Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over the EP reference (311) in view of Nakasuji (341).

Nakasuji teaches loops 51, 40, 41 of parallelepiped shape. To modify the loops of the EP reference (311) to be parallelepiped in shape, would have been obvious in view of the teaching of Nakasuji, to optimize the strength of the locking connection between the covers.

Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over the modified EP reference (311) as applied to claim 21 above, and further in view of Nakasuji (341).

To modify the shape of the loops of the modified EP reference (311) to be parallelepiped in shape, would have been obvious in view of the teaching of Nakasuji, to optimize the strength of the locking connection between the covers.

Claims 26, 42, 43, 49, 50 and 75 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Mitsuyama (648) also teaches a lock used with covers.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lloyd A. Gall whose telephone number is 703-308-0828. The examiner can normally be reached on Monday-Friday, 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Knight can be reached on 703-308-3179. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-2168.

LG LG

Lloyd A. Gall
Primary Examiner